

**REMARKS**

In the Office Action, the Examiner rejected claims 1, 2, 5, 6, 8, 13, 14, 21, 22, 24, 25, and 27-29 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,504,502 to *Arita et al.* ("Arita"); rejected claims 3 and 23 under 35 U.S.C. § 103(a) as not being patentable over *Arita* in view of U.S. Patent No. 5, 179,460 to *Hinata et al.* ("Hinata"); rejected claim 4 under 35 U.S.C. § 103(a) as not being patentable over *Arita* in view of U.S. Patent No. 5,565,632 to *Ogawa*; rejected claims 18 and 33 under 35 U.S.C. § 103(a) as not being patentable over *Arita* in view of U.S. Patent No. 6,670,946 to *Endo et al.* ("Endo"); and objected to claims 7, 9-12, 15-17, 19, 20, 26, 30-32 and 34-35 as having allowable subject matter but depending from a rejected base claim.

Applicants gratefully acknowledge the Examiner's indication of allowable subject matter in claims 7, 9-12, 15-17, 19, 20, 26, 30-32 and 34-35.

By this Amendment, Applicants amend claims 1, 2, 18, and 19, canceled claims 21-35, and add new claims 36-38. Claims 1, 2, 18, and 19 are amended for improved readability. Claims 36-38 are added to capture subject matter of allowable claims 9, 19, 20, 34 and 35. Claims 1-20 and 36-38 are pending.

More specifically, new claim 36 incorporates subject matter of claim 9 indicated by the Examiner as being allowable. (Office Action, p. 6:9-11.) Accordingly, claim 36 is allowable for at least this reason.

New claim 37 incorporates subject matter of claims 19 and 34 indicated by the Examiner as being allowable. (Office Action, p. 7:8-12.) Accordingly, claim 37 is allowable for at least this reason.

New claim 38 incorporates subject matter of claims 20 and 35 indicated by the Examiner as being allowable. (Office Action, p. 7:13-17.) Accordingly, claim 38 is allowable for at least this reason.

Applicants note that the rejections of claims 21-25, 27-29, and 33 under 35 U.S.C. §103(a) are moot in light of the cancellation of these claims.

Although Applicants do not necessarily agree with the above-noted rejections, Applicants have amended independent claim 1 to clarify the claimed subject matter. Support for the changes to claim 1 may be found in the specification at, for example, pages 18:24 to 19:7, 26:22 to 28:1, and FIGs 12A & 12B.

Generally, applicants' specification discloses different embodiments of a pointing device for detecting ambient magnetic field changes caused by the movement of a magnet. The pointing device has an elastic member that is displaceable with respect to a printed circuit board. The pointing device may advantageously allow the elastic member to be deformed by an external force, enabling the magnet to sway in any desired direction, vertical or horizontal, and to return the magnet to its initial position when the external force is removed. This return is preferably effected without the use of coil springs or other external forces to the elastic member. Magnetic sensors may be

used to detect magnetic flux density changes caused by a sway of said magnet due to elastic deformation of said elastic member and, therefore, achieve a highly sensitive pointing device with a high degree of ease of use. Furthermore, the disclosed structure may facilitate the assembly, enable downsizing, and increase the lifespan of a pointing device, thereby being able to benefit a wide variety of applications.

Rejection Under 35 U.S.C. § 102(b)

Applicants respectfully traverse the rejection of claims 1, 2, 5, 6, 13 and 14 under 35 U.S.C. § 102(b). In order for *Arita* to anticipate Applicants' claimed invention under Section 102(b), each and every element of each claim in issue must be found, either expressly described or under principles of inherency, in the reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." (See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).)

*Arita* cannot anticipate claim 1 under 35 U.S.C. § 102(b) because the reference does not disclose, at least, that an "elastic member is adapted to be deformed by an external force and to return the magnet to an initial position when the external force is removed," as recited in amended claim 1. *Arita* discloses a pointing control device including a slider 10, a housing 13, a printed circuit board 17, a permanent magnet 18, and a casing 19. (Col. 4:38-50.) Slider 10 also includes an elastic member 11 and dome-shaped member 12. (*Id.*) The Examiner apparently alleges that elastic member 11, and dome-shaped member 12 correspond to the claimed "elastic member;" and that printed circuit board 17, and permanent magnet 18 correspond to claimed "printed

circuit board" and "magnet," respectively. (Office Action, p. 2.) Slider 10, however, provides a "free sliding movement" on housing 13. (Col. 4:40-45.) Thus, elastic member 11 does not "return the magnet to its initial state when the external force is removed," as recited in amended claim 1. Indeed, to provide such functionality in some embodiments, *Arita* discloses "return means such as garter springs" for automatically returning slider 10 to its origin. (Col. 7:59-67.) *Arita*, therefore, fails to teach at least this feature of claim 1.

In addition, slider 10 appears to be captured between housing 13 and casing 19 and, as noted above, has only a limited "free sliding movement" on the surface of housing 19. (Col. 4:41-45.) For instance, in the embodiment illustrated in FIGs. 7A-7C, slider 10 cannot move in a direction parallel to printed circuit board due to the dome-shape of slider 10 and housing 13. Accordingly, *Arita* does not disclose "an elastic member mounted on said printed circuit board, the elastic member having a hollow for enabling sway in any desired direction" (emphasis added), as recited in claim 1.

Furthermore, the Examiner apparently asserts that *Arita* discloses a "hollow," as recited in claim 1. (Office Action, p. 2.) However, because the alleged hollow is formed by elastic member 11, a dome-shaped member 12, a housing 13, and a printed circuit board 17 (see, e.g., FIG. 1), *Arita* fails to teach an "elastic member having a hollow" where "said hollow being enclosed by said printed circuit board," as recited in amended claim 1.

Applicants note that Figure 28 of *Arita* teaches a hole member 61 formed of an elastic material "having relatively large elastic modules," allowing "a self-alignment to the origin position by the elastic force thereof." (Col. 10:24-28.) Hole member 61 does not, however, teach or suggest "an elastic member mounted on said circuit board ... said hollow being enclosed by said printed circuit board," as recited in amended claim 1.

Accordingly *Arita* fails to disclose "an elastic member mounted on said printed circuit board [to constitute] the elastic member having a hollow for enabling sway in any desired direction ... wherein said elastic member is adapted to be deformed by an external force and to return the magnet to an initial position when the external force is removed, said hollow being enclosed by said printed circuit board, and said plurality of magnetic sensors detect magnetic flux density changes caused by a sway of said magnet due to elastic deformation of said elastic member," as recited in claim 1. *Arita*, therefore, cannot anticipate claim 1 under 35 U.S.C. § 102(b) and claim 1 is allowable over *Arita*. Claims 2, 5, 6, 8, 13 and 14 are also allowable over *Arita* at least due these claims' dependence from claim 1. Moreover, Applicants note that, for at least the above-noted reasons, the pointing control device disclosed by *Arita* cannot achieve the aforementioned advantages of the claimed "pointing device."

Rejection Under 35 U.S.C § 103(a)

Applicants traverse the rejection of claim 3, 4 and 18 under 35 U.S.C. 103(a). In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art references must teach or suggest all of the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in

the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143. Here, the cited references cannot establish a *prima facie* case of obviousness because *Hinata*, *Ogawa*, and *Endo* taken alone or in any proper combination, do not teach or suggest each and every feature recited in Applicants' claims.

Claims 3, 4 and 18 depend from claim 1 and, therefore, include all of the limitations of claim 1. As noted above, *Arita* does not disclose or suggest, "an elastic member mounted on said printed circuit board [to constitute] the elastic member having a hollow for enabling sway in any desired direction ... wherein said elastic member is adapted to be deformed by an external force and to return the magnet to an initial position when the external force is removed, said hollow being enclosed by said printed circuit board, and said plurality of magnetic sensors detect magnetic flux density changes caused by a sway of said magnet due to elastic deformation of said elastic member," as recited in claim 1. *Hinata*, *Ogawa*, and *Endo* do not overcome these deficiencies.

The Examiner cites *Hinata* for allegedly disclosing an elastic layer consisting of a silicon resin (Office Action, p. 4); *Ogawa* for allegedly disclosing elastic material formed of ferrite rubber into which a magnetic material is dispersed (Office Action, p. 5); and *Endo* for allegedly disclosing a second magnet (*Id.*). However, neither *Hinata*, *Ogawa*, nor *Endo* disclose the above noted features missing from *Arita*, and the Examiner does not rely on these references for such disclosure. Therefore, claims 3, 4, and 18 are

allowable over the applied references because *Arita*, *Hinata*, *Ogawa*, and *Endo* taken alone or in combination, cannot support a rejection of claims 3, 4 and 18 under 35 U.S.C. § 103(a).

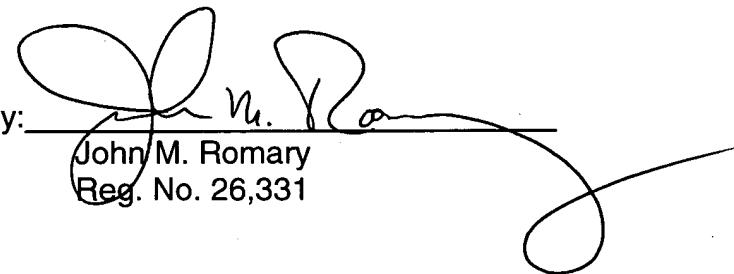
In view of the foregoing, Applicants respectfully submit that claims 1-20 are in condition for allowance. Applicants therefore request the Examiner's reconsideration and timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By:   
John M. Romary  
Reg. No. 26,331

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